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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,492	08/07/2001	Barry E. Willner	101.061	2291

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BUCKLEY, MASCHOFF, TALWALKAR LLC  
5 ELM STREET  
NEW CANAAN, CT 06840

EXAMINER
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LY, NGHI H

ART UNIT	PAPER NUMBER
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2686

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DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/923,492

**Applicant(s)**

WILLNER ET AL.

**Examiner**

Nghi H. Ly

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-22 and 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Grube et al (US 5,778,304).

Regarding claims 1, 25, 28-30, Grube teaches a method of facilitating compliance with location dependent requirements (see column 2, lines 13-28), comprising: determining location information associated with a user and see column 2, lines 54-57, determining requirement information based on the location information (see column 3, lines 30-52), and facilitating the user's compliance with the requirement information (also see column 3, lines 30-52, see "The message maybe the text message for display on the communication unit informing the user of these altered").

Regarding claim 2, Grube further teaches the location information is associated with at least one of: (i) latitude and longitude information, (ii) map coordinate information, (iii) a location type, and (iv) an indication of a geographic region (column 2, lines 37-40, see "global positioning satellite receiver").

Regarding claim 3, Grube further teaches the determination of the location information is performed via at least one of (i) a global positioning system device, (ii) a

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wireless communication network device, (iii) a wireless telephone, and (iv) a Bluetooth device (also see column 2, lines 37-40, see "global positioning satellite receiver").

Regarding claim 4, Grube further teaches the requirement information is associated with at least one of: (i) a law, (ii) a regulation, and (iii) a rule (see column 3, lines 30-42).

Regarding claim 5, Grube further teaches the requirement information is associated with at least one of: (i) a user action, and (ii) operation of a user device associated with the user (see column 3, lines 43-52).

Regarding claim 6, Grube further teaches the user is associated with a mobile user device, and the mobile user device comprises at least one of: (i) a portable computing device, (ii) a personal digital assistant, (iii) a vehicle, (iv) an automobile, (v) a communication device, (vi) a wireless telephone, (vii) a pager, (viii) a container, and (ix) a weapon (see fig.1, communication units 102, 103).

Regarding claims 7 and 10, Grube further teaches the determination of the location information comprises: receiving the location information at a requirement controller from a remote user device (see fig.1, wireless connection between communication units 102 and communication resource 104).

Regarding claims 8 and 12, Grube further teaches receiving occurs at least one of: (i) periodically, (ii) upon a change in a location type, and (iii) in association with a requirement request (see column 2, lines 54-67).

Regarding claim 9, Grube further teaches transmitting the requirement information to the user device (see column 3, lines 30-42).

Regarding claim 11, Grube further teaches transmitting the location information to the requirement controller (see abstract).

Regarding claim 13, Grube further teaches at least one of the following are also transmitted from the user device to the requirement controller: (i) a user identifier, (ii) a user device identifier, (iii) a requirement request, (iv) a requirement type, (v) user preference information, and (vi) supplemental information (see column 3, lines 30-42).

Regarding claim 14, Grube further teaches receiving the requirement information from the requirement controller (see column 3, lines 30-42).

Regarding claim 15, Grube further teaches arranging for an indication to be provided to the user in accordance with the requirement information (column 3, lines 30-42, see "display").

Regarding claim 16, Grube further teaches the indication comprises at least one of: (i) text information, (ii) audio information, and (iii) graphical information (column 3, lines 30-42, see "The message maybe the text message for display on the communication unit informing the user of these altered").

Regarding claim 17, Grube further teaches the indication includes at least one of: (i) a description of a requirement, and (ii) a penalty associated with the requirement (column 3, lines 30-42, see "setting predetermined volume levels").

Regarding claim 18, Grube further teaches the facilitating is further based on supplemental information (see column 3, lines 30-42).

Regarding claim 19, Grube further teaches the supplemental information is associated with at least one of: (i) operation of a user device, (ii) weather information,

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(iii) a current time, (iv) a current date and (v) user information (also see column 3, lines 30-42).

Regarding claim 20, Grube further teaches the facilitating comprises: automatically arranging for a user device to operate in accordance with the requirement information (see column 1, lines 65-67).

Regarding claims 21 and 24, Grube further teaches the determination of the location information is performed by a user device (see column 4, lines 9-14), and the user device determines requirement information via a local location dependent requirement database (see column 3, lines 30-42).

Regarding claims 22 and 26, Grube further teaches the determination of the requirement information is associated with at least one of: (i) a location dependent requirement database, (ii) a rules-based system, (iii) a statistical analysis, (iv) human judgment, and (v) a third-party service (column 2, lines 41-67, see "database").

Regarding claim 27, Grube further teaches a communication device coupled to said processor and adapted to communicate with at least one of: (i) a user device, (ii) a requirement controller, (iii) a supplemental information device, and (iv) a payment device (the teaching of Grube inherently teaches a communication device coupled to said processor and adapted to communicate with at least one of: a user device (see fig.1, communication unit 101, a requirement controller (see fig.1, wireless connection between communication units 102 and communication resource 104), a supplemental information device (see column 3, lines 30-42).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grube et al (US 5,778,304) in view of Tendler (US 6,519,463).

Regarding claims 23, Grube teaches claim 1. Grube does not specifically disclose arranging to receive payment in exchange for facilitating compliance with the location dependent requirements.

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Tender teaches arranging to receive payment in exchange for facilitating compliance with the location dependent requirements (see column 5, lines 14-21 and column 6, lines 1-5).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Tender into the system of Grube in so that the provider can collect the service fee from the user.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Stewart (US 6,546,257) teaches providing promotional material based on repeated travel pattern.
- b. Zeytoonjian (US 5,438,319) teaches golf cart control and monitoring apparatus.
- c. Kowaguchi (US 6,201,973) teaches mobile communication apparatus.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone



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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

11065  
04/07/04

*Marsha D Banks-Harold*

MARSHA D. BANKS-HAROLD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600